



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,395	09/22/2003	John Butler	08203.0005-04000	4412
22852	7590	07/30/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
07/30/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,395

Applicant(s)

BUTLER ET AL.

Examiner

Anu Ramana

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6-9, 14-25, 27-36, 55-57 and 61 is/are pending in the application.
- 4a) Of the above claim(s) 9, 17-25 and 27-36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6-8 and 14-16 is/are allowed.
- 6) ☒ Claim(s) 55-58 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/18/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55-57 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 55, the recitation "opening distally away from the insertion tool" renders the claim vague and indefinite because the structure being recited is unclear. The "retractor receiving portion" is located at a distal end of the insertion tool. Therefore, it is unclear what structure is being claimed by the recitation "the retractor receiving portion opening distally away from the insertion tool?" Is Applicant trying to claim a taper at the distal end?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

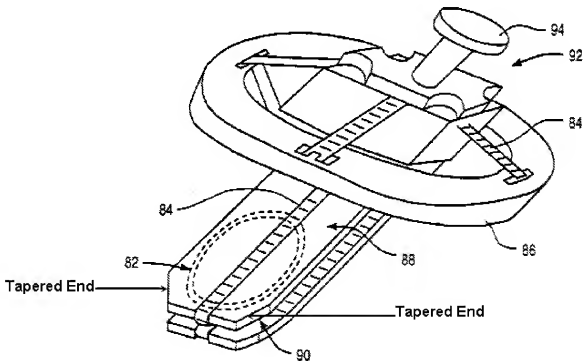
Claims 55-58 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. (US 5810721).

Mueller et al. disclose a retractor including: a retracting member 96 extending substantially continuously around a distal ring member 82 mounted to the retracting member, the distal ring member 82 being made of a flexible material; and an obturator or insertion tool 88 wherein the insertion tool 88 has a channel or groove 90 facing distally away from the insertion tool for completely receiving a distal portion of the

retractor (Figs. 10A, 10B, and 10C, col. 6, lines 27-51, col. 10, lines 34-67 and col. 11, lines 1-2).

Regarding claim 55, Mueller et al. disclose all elements of the claimed invention as discussed above. It is noted that pushrod 95 is monolithic.

Regarding claim 58, Mueller et al. clearly disclose the distal end of obturator 88 to have a taper (see marked up Fig. 10B provided below) when the retractor is received in the groove or longitudinal channel 89 of the insertion tool. Shaft 95 of the insertion tool engages the retractor when it is used to push the retractor out.



Regarding claim 61, Mueller et al. disclose the insertion tool to have inward facing or tapered surfaces 90 that define a groove and an opening, the opening facing the wound opening during deployment.

Response to Arguments

Applicant's arguments filed on May 14, 2010 have been fully considered. Applicant's arguments with respect to the rejection of claims 55-57 and 61 under 35 U.S.C. 102(b) as being anticipated by Mueller et al. (US 5810721) are not persuasive for the following reasons.

Mueller et al. disclose an obturator or insertion tool 88 with a wound engaging portion (distal portion of the obturator) including a monolithic shaft 95. It is noted that the phrase "consisting essentially of" does not preclude the presence of other elements as Applicant appears to be arguing. Claim 55 merely recites the insertion tool to have a wound engaging portion including a monolithic shaft. With respect to the phrase "wound engaging" it is noted that this is merely functional in nature and does not imply any structure to distinguish Applicant's claimed invention over Mueller et al. Obturator 88 has a longitudinal channel or opening or "retractor receiving portion" 89 at a distal end of the insertion tool to receive the retractor.

Allowable Subject Matter

Claims 1, 6-8 and 14-16 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
July 29, 2010

/Anu Ramana/
Primary Examiner, Art Unit 3775